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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/836,501	04/17/2001	Lawrence M. Kaplan	N0089US	8539

7590

03/24/2003

NAVIGATION TECHNOLOGY
222 MERCHANDISE MART PLZ. STE 900
CHICAGO IL. 60654-1105

EXAMINER	
LOUIS JACQUES, JACQUES H	
ART UNIT	PAPER NUMBER
3661	5-22-03
DATE MAILED: 03/24/2003	

DRS

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/836,501

Applicant(s)

KAPLAN, LAWRENCE M.

Examiner

Jacques H. Louis-Jacques

Art Unit

3661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-17 and 20-23 is/are rejected.
- 7) ☒ Claim(s) 18 and 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>9</u> . | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

2. Claims 8-10, 14-17, 20-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Liu et al [6,400,690].

Liu et al discloses a dual map system, for navigation and wireless communication, wherein a user using a computing device (110) establishes a wireless communication link through a wireless communications device (115) with a remotely located navigation services provider (101). According to Liu et al, as set forth in the abstract and column 2, for example, the user obtains wireless coverage data from the remotely located navigation service provider. The system of the remotely located navigation services provider comprises several managers including a coverage manager for indicating areas in which navigation-related data from the navigation services provider are available or unavailable wirelessly, i.e., the system indicates the user whether he/she is in an area covered wirelessly. See column 3 and figure 1.

Additionally, Liu et al discloses an output device (111), such as a display (column 2) for displaying on a screen areas in which navigation related data from the services providers are available or unavailable wirelessly.

Furthermore, Liu et al discloses, as described in the abstract and column 2, in particular, providing a warning to the user that he is or he is out of an area covered wirelessly by the navigation related services provider. The output device (111) of Liu et al can be a speaker or a display; thereby the warning is provided either audibly or visually. See columns 2-3.

In column 4, Liu et al discloses that the coverage manager interacts with a GPS for predicting the future wireless coverage, wherein the coverage manager notifies the user that he/she will soon lose coverage or soon will regain coverage and then the coverage manager refines the coverage map. That is, the coverage manager downloads data for a second area prior to leaving a first area. As further described in columns 4 and 5, the second area corresponds to a destination to which the user is traveling and which is located outside the first area. Also, the second area corresponds to a portion of a route on which the user's vehicle is located.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu et al in view of Pu et al [6,292,743]

Liu et al does not particularly disclose highlighting or coloring of the map data and indicating boundaries. Pu et al, on the other hand, discloses a mobile navigation system, which establishes a wireless communication with a navigation server, wherein the map data that are available or unavailable are highlighted. Also, according to Pu et al, there is provided an indication of the boundaries where the data are available. See for example column 10 thus, it would have been obvious to one skilled in the art at the time of the invention to be motivated to modify the dual map system of Liu et al by incorporating the features from the mobile navigation system of Pu et al, such modification, will eliminate or reduce the burden on the user.

Allowable Subject Matter

5. Claims 18 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art of record do not particularly discloses restricting selection of destinations and routes to those in which navigation-related data from the navigation services provider are available wirelessly as claimed.

Response to Amendment

6. Applicant's arguments filed on February 6, 2003 have been fully considered but they are not persuasive.

The cancellation of nonelected claims 1-7 has been acknowledged.

Applicant has amended the claims to recite that the wireless coverage is a wireless "navigation services" coverage. All the amended claims include such limitation.

Applicant argued that the wireless coverage disclosed in the Liu patent relates to a wireless communications coverage, not wireless **navigations services** coverage.

According to Applicant, "the fact that Liu discloses that end users have navigation systems (102 in Figure 1 of Liu) in their vehicles that calculate route and provide other navigation-related functions using street=coverage mps located on storage devices 116 located in their vehicles", is a basis to confirm his position that Liu fails to discloses the identification of geographic areas of wireless services availability (or unavailability).

Emphasis added.

The examiner disagrees.

What applicant fails to mention is that the system control unit (101), which the navigation manager (102) is a part of, is used to combining information from a group of mobile wireless users. Once it is determined that wireless navigational services are not available for a particular area, the control unit utilizes the navigation services stored therein. See figures 2 and 5. See also column 1, line 63 to column 2, line 2. See, in particular, column 4, lines 3-9, 36-54.

As to the Pu patent, the arguments regarding the wireless "navigation services" coverage have been addressed with reference to the Liu patent.

Accordingly, the claims remain rejected and this office action made final.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacques H. Louis-Jacques whose telephone number is (703) 305-9757. The examiner can normally be reached on M-Th, 7:30 AM - 4:00 PM (Eastern Time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William A. Cuchlinski can be reached on (703) 308-3873. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1111.

Jacques H. Louis-Jacques
Primary Examiner
Art Unit 3661

/jlj
March 17, 2003

Jacques H. Louis-Jacques
JACQUES H. LOUIS-JACQUES
PRIMARY EXAMINER